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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,779	11/17/2003	Thomas G. Corbett	D5407-215	4558
25397	7590	06/16/2005	EXAMINER	
DUANE, MORRIS, LLP			GAY, JENNIFER HAWKINS	
3200 SOUTHWEST FREEWAY			ART UNIT	
SUITE 3150			PAPER NUMBER	
HOUSTON, TX 77027			3672	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,779

Applicant(s)

CORBETT, THOMAS G.

Examiner

Jennifer H. Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application:
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/17/03 4/5/04</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because the abstract includes the implied phrase "are described". Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

3. Claims 10 and 15 are objected to because of the following informalities: in claim 10 there is a lack of antecedent basis for "said closed position" and it is believed that claim 15 should depend from claim 14 and will be treated as such for the purposes of examination.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rebaridi et al. (US 4,858,690).

*Regarding claim 1:* Rebardi et al. discloses a gravel packing method that involves the following steps:

- Running in a packer **72** and a screen assembly **70**.
- Inserting a crossover assembly **80** that supports a wash pipe **89** at least in part into the packer.
- Providing a seat **223** on the crossover to accept an obstructing object **225** for setting the packer.
- Positioning the seat so that pressure can be built up on the object to a predetermined level without an effect from downhole pressure acting below the object on the seat (8:35-52, 12:4-7). *The examiner notes that the packer is set by tubing pressure in the flow bore 27 which would require an obstruction in the tubing in order to create the pressure.*

*Regarding claim 2:* The method further involves providing at least one gravel outlet port **116** in the crossover and selectively obstructing, element **117**, the outlet port from downhole pressure when setting the packer. *The examiner notes that element 117 would have to be obstructing the outlet ports in order to allow the tubing to be pressurized.*

*Regarding claim 3:* The method further involves locating the seat further downhole on the crossover than the outlet port (Figure 2).

*Regarding claim 4:* The method further involves providing a clearance in the bore **27** of the packer as it is set and allowing a fluid column to act through the clearance during setting of the packer (8:35-52) to exert pressure on the formation below the packer for resisting cave-ins into the wellbore. *The examiner notes that a pressurized wellbore would inherently aid in the resistance of cave-ins.*

*Regarding claim 5:* Rebardi et al. discloses a gravel packing method that involves the following steps:

- Running in a packer **72** and a screen assembly **70**.
- Inserting a crossover assembly **80** that supports a wash pipe **89** at least in part into the packer.

- Moving the crossover from a first position (Figure 9) for setting the packer to a second position (Figures 10 and 11) after the packer is set.
- Depositing gravel outside the screen using circulation through the crossover when in the second position (13:48-59).
- Maintaining the second position after depositing.
- Reversing excess gravel after the step of depositing by flowing fluid in a direction opposite to that during the deposition of the gravel bit isolating the reverse flow from passing through the screen.

*Regarding claim 6:* The method further involves supporting the crossover in the second position so that ports **196** are open to provide fluid communication, in a first path, between the inside of the wash pipe and an annular space **45** above the packer (Figure 10, 13:50-56).

*Regarding claim 7:* The method further involves supporting the crossover in the second position, shoulder **144**, so that gravel ports **116** are open to provide fluid communication, in a second path, through the crossover and to an annular space **201** between the wash pipe and the screen and out to the outside of the screen.

*Regarding claim 8:* The method further involves providing unidirectional flow access, with a first check valve **191**, from inside the wash pipe to the annular space between the wash pipe and the screen.

*Regarding claim 9:* The method further involves preventing flow down the wash pipe toward the screen with a second check valve **222** that permits flow through the wash pipe coming from the screen.

*Regarding claims 10, 13:* The method further involves providing a shutoff valve **244** in the wash pipe to selectively close it while the crossover is in the second position and performing a squeeze operation with the shutoff valve in the closed position.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

Art Unit: 3672

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 14 of copending Application No. 10/631,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3 of the instant application are merely broader recitations of claims 1-3 and 14 of Application No. 10/631,263. The specific correlation between the claims is as follows:

- Claim 1 – Claims 1 and 2 of Application No. 10/631,263.
- Claim 2 – Claim 14 of Application No. 10/631,263.
- Claim 3 – Claim 3 of Application No. 10/631,263.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

8. Claims 11, 12, 14, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

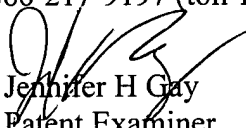
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

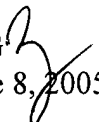
The remaining references made of record disclose various wellbore valves and gravel packing methods.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H Gay  
Patent Examiner  
Art Unit 3672

JHG   
June 8, 2005